

## **REMARKS**

The official action of 4 February 2010 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 6 has been amended with the incorporation of subject matter formerly in claim 10 (now canceled). Claims 1, 3, 5, 10 and 18 have been canceled.

Applicants respectfully note that this amendment does not present a new issue after final since the subject matter incorporated into the independent claim 1 was already in the application. Moreover, Applicants respectfully submit that the present rejection based on a newly cited reference (Miyabayashi, see below) was not necessitated by Applicants' amendment to the claims such that the rejection should not have been made final in the first place. See MPEP 706.07(a). Accordingly, should the present response not result in an allowance of this application, Applicants respectfully submit that they should be given an opportunity to traverse any remaining rejection to the claimed subject matter in the present application.

Claim 6 has also been amended to correct the typographical error in the term "prigrams" (sic: "pigments") whereby to remove the basis for the claim objection on page 2 of the official action. All other claims have been amended to depend, either directly or indirectly, from claim 6.

The claims were rejected under 35 USC 103(a) as allegedly being unpatentable

over Miyabayashi. Applicants respectfully traverse this rejection.

The claimed invention is based at least in part upon Applicants' discovery of the result effective nature of the recited mixing ratio of the claimed pigments. Specifically, Applicants discovered that the claimed magenta ink composition can provide for excellent color reproducibility of a high-chroma and low-lightness red region and can also obtain excellent granularity when the recited pigments, Pigment Violet 32 (PV32) and Pigment Violet 19 (PV19), are both present in the recited mixing ratio. This is described in the specification as filed at, for example, paragraph [0086], and is exemplified in Working Example B of the Examples at paragraphs [0191] - [0230].

Working Example B shows ink compositions comprising both PV 32 and PV19 in mixing ratios of 1 : 1; 2 : 1; and 1 : 2 (see description of Working Examples 1-4 at paragraphs [0202] - [0205]) whereas Comparative Examples 1-3 are ink compositions comprising only one of Pigment Violet 202 (PV202), PV19 and PV32 respectively. The ink compositions of the Working Examples and Comparative Examples were subjected to the evaluations described in the specification at paragraphs [0209] - [0211] and the results are shown in Tables 15 to 21 at paragraphs [0212] - [0218]; Tables 22-23 at paragraphs [0224] - [0228] and in Figs. 5-7 of the drawings . As discussed in the specification at paragraphs [0219] to [0230], the ink compositions of the Working Examples 1 to 4 have excellent color reproducibility in a high-chroma and low-lightness red region and also excel in granularity. In contrast, the ink compositions of the Comparative Examples comprising only one of the pigments either had poor coloring ability of a dark section in the high-a\* region (Comparative Example 2- -see paragraph [0221]) or had a low L\*value in a low-a\* region and poor

granularity (Comparative Examples 1 and 3- -see paragraph [0221]).

The cited reference, Miyabayashi, lists a large number of pigments for use with the ink compositions described therein, but does not show or suggest the use of a mixture of PV19 and PV32 in the claimed **mixing ratio** and does not recognize the result effective nature of this **ratio**. Miyabayashi merely enumerates PV32 and PV19 as magenta pigments. In its Examples, Miyabayashi exemplifies the use of PR122 as a magenta pigment, but does not exemplify the use of either PV32 or PV19 (see paragraph [0318] of Miyabayashi). In short, Miyabayashi fails to disclose or suggest a mixture of PV32 and PV19 in the claimed mixing ratio.

In the absence of anything in the cited reference that would show or suggest that the claimed **mixing ratio** is a result effective variable, Applicants respectfully submit that the reference cannot set forth even a *prima facie* case of obviousness for the invention as claimed. See MPEP 2144.05(II)(B) (“A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”). The Examiner contends that it would have been obvious to one of skill in the art to optimize the amounts of the Miyabayashi components, but this is not the case where as here the prior art does not recognize that it is a ratio that must be optimized. See, *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result- effective

variable.).

For the above reasons, Applicants respectfully submit that the cited reference is incompetent to set forth even a *prima facie* case of obviousness for the claims as amended. Moreover, even assuming for the sake of argument that the reference were competent to set forth a *prima facie* case, Applicants respectfully submit that the evidence of record in the specification Examples (see discussion above) would be sufficient to rebut the same. In this connection, the examples in Miyabayashi comprise only PR122 as a magenta pigment, whereas the comparison in the present specification was with respect to compositions comprising PR19 (Comparative Example 2) and PR32 (Comparative Example 3). Accordingly, the comparison in the specification is with respect to ink compositions that are closer than those exemplified in the reference. See MPEP 716.02(e) (“Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner.”).

In view of the above, Applicants respectfully submit that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Please charge Account No.12-0425 for any fees which may be due by this paper.

Respectfully submitted,

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